

from a peptide library, thereby, identifying the cellular ligand to the biologically active ribonucleic acid.

R E M A R K S

New claims 118-139 are presented for consideration in place of claims 71-118.

Claims 118-139 correspond to claims 71, 74-77, 80-86, 88, 95, 100-104, 109, and 111, respectively, revised in order to address the claim objections and the instances of alleged indefinite claim language identified in the rejection under 35 U.S.C. § 112, second paragraph, and revised by deleting subject matter relating to the method for identifying the biologically active "peptide."

Applicants wish to thank Examiners R. Schwartzman and W. Sandals for the courteous consideration rendered to Applicant's representative during an interview at the Patent and Trademark Office on January 5, 2001, and during the subsequent interview by telephone on or about 18 January 2001.

During the aforesaid interview at the PTO, the claims of record were discussed with respect to the rejections of record set forth in the final Office action mailed December 5, 2000. In particular, the rejection of record for alleged obviousness under 35 U.S.C. § 103 was discussed, with respect to distinctions between the invention defined in the claims of record and the references relied on in the statement of rejection. The Examiners agreed that they needed to reconsider the § 103 rejection for alleged obviousness in view of the discussions had during the interview. In the event, that after further consideration, the Examiners maintained the rejection for alleged obviousness under § 103, possible claim amendments were suggested; however, the parties agreed that Applicants would not submit any claim amendments until the Examiners had decided whether to maintain or withdraw the rejection of record for alleged obviousness under § 103 and informed Applicants' representative of their decision.

Also during the aforesaid interview at the PTO, U.S. Patent No. 6,153,380 (Nolan) was discussed. Nolan is not prior art against the instant application, as the present application has an earlier priority date. The claims of Nolan were discussed, and whether Nolan's claims defined any subject matter in common with the invention as defined by the claims of record in the instant application. The Examiners agreed that they would need to consider the matter further.

During the aforesaid telephone interview, Applicants' representative was informed that, after further consideration, the Examiners decided to withdraw the rejection of claims 71-117 under 35 U.S.C. § 103 for alleged obviousness based on WO 95/04824 in view of LaBean et al., Dube et al., WO 94/29469, U.S. 5,935,823, Karttunnen et al., and VonMelchner et al.

No decision has been made by the PTO as to whether claims 71-117 define subject matter in common with the claims of Nolan; however, the issue is rendered moot by the present amendment. The present claims define a method for identifying a biologically active "ribonucleic acid"; that is, as indicated above, subject matter relating to the method for identifying a biologically active "peptide," has represented in claims 71-117, is not present in claims 118-139, submitted hereby. No subject matter relating to a method for identifying a biologically active "ribonucleic acid," as defined in the present claims, is found anywhere in the claims, or specification, of Nolan. In other words, there is nothing in Nolan indicating that Nolan's invention concerned the presently claimed subject matter relating to "a biologically active ribonucleic acid."

In the final Office action, claims 71-117 were rejected under 35 U.S.C. § 112, second paragraph, or allegedly containing indefinite claim language. As mentioned, above, the language found in claims 118-139 address the instances of indefinite claim language alleged in the statement of rejection.

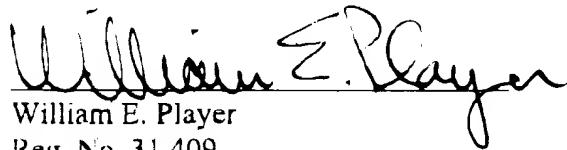
The requisite standard for determining indefiniteness under §112, ¶2, is whether one of ordinary skill in the art would be confused as to the meaning of subject matter defined by the language at issue. *In re Kroekel*, 183 USPQ 610 (CCPA 1974). Applying this standard to the claims presented, hereby, demonstrates that the language presented by the new claims satisfies the requirements of 35 USC 112, ¶2. Accordingly, the rejection under § 112, paragraph two, is in order to be withdrawn.

Favorable action is requested.

Respectfully submitted,

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